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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,309	11/07/2000	Patti C. Gilmer	FPC3 (6208.tba)	1250
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Kenneth Southall Troutman Sanders LLP 600 Peachtree Street NE Suite 5200 Atlanta, GA 30308-2216				
EXAMINER WRIGHT, ANDREW D				
ART UNIT		PAPER NUMBER		
3617				

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,309

Applicant(s)

GILMER, PATTI C.

Examiner

Andrew Wright

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 19-21 and 23-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 19-21 and 23-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/27/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/04 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 25 recites the limitation "the swimsuit fabric" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 19, 20, 21, 24, 27, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Darcy et al. (US 5,823,838). Darcy discloses a form fitting torso covering in figures 2 and 3. The torso covering comprises pockets (10, 11, 12, 13, 14, 15, 16) (see column 14, lines 42-67). A flotation element comprising buoyancy material is placed in each pocket (column 15, lines 1-4). Darcy discloses a configuration of the buoyancy material in figure 20 and lines 45-56 of column 16. Darcy discloses that the flotation element can be a unitary flotation element comprising a backsheet (92) of buoyant material and raised protuberances (91) that extend outwardly from the backsheet (92). Darcy teaches that this buoyancy material may be placed in pockets such as formed in the life-jackets illustrated in the previous embodiments. Thus the flotation element shown in figure 20 can be placed in any of the pockets (10-16) shown in the vest of figures 2 and 3. The vest of figures 2 and 3 with the flotation element (90) in each pocket contains all of the elements of claim 19.
7. Regarding claim 20, pocket (13) is in the upper torso region. Therefore the protuberances (91) constitute an enhanced upper torso region.
8. Regarding claim 21, pocket (11) is in the lower torso region. Therefore the protuberances (91) in that pocket constitute an enhanced lower torso region.
9. Regarding claim 24, it can be seen from figure 20 that a channel is formed between the raised portions. The channel is capable of allowing the flotation element to flex.

10. Regarding claim 27, Darcy discloses that the vest has a front opening (4) closed by a conventional zip.
11. Regarding claim 28, the vest has a pair of rear pockets (15, 16). Each can have a flotation element (90) with backsheet (92) and enhanced regions (91).
12. Regarding claim 29, it can be seen from figure 20 that a channel is formed between the raised portions. The channel is capable of allowing the flotation element to flex.
13. Claims 31-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Frieder et al. (US 2,629,118). Frieder shows a buoyant vest with numerous flotation elements. The left front element is described in lines 25-44 of column 3, and is shown in figure 4. The left front flotation element comprises backsheet (12) and enhanced buoyancy regions (13). The backsheet comprises a layer of buoyant material of a primary thickness. The enhanced regions are integrally carried by the backsheet (see column 3, lines 34-37). The enhanced buoyancy regions have a thickness substantially greater than the primary thickness. The enhanced regions extend outwardly from the backsheet. The claim does not recite a frame of reference for the term "outwardly".
14. The recitations "to provide general buoyancy about a wearer's torso" and "to provide enhanced buoyancy to a strategically ... to a user's torso" are intended use recitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the Frieder flotation element is capable of performing the intended use.

15. Regarding claim 32, Frieder shows that the enhanced region extends into the upper torso region of the vest. It is noted, however, that even if Frieder did not show the location of the flotation element on the vest, the flotation element alone would read on the claim. The recitation that the flotation element is for the upper torso is an intended use recitation.

16. Regarding claim 33, Frieder shows that the enhanced region extends into the lower torso region of the vest. It is noted, however, that even if Frieder did not show the location of the flotation element on the vest, the flotation element alone would read on the claim. The recitation that the flotation element is for the lower torso is an intended use recitation.

17. Regarding claim 34, Frieder shows a channels (14) between the enhanced regions (13). This channel constitutes a flexion channel since it is capable of allowing the backsheet to flex.

18. Regarding claim 35, looking at figure 4 of Frieder, one of the ribs (13) is the upper torso enhanced region, and two of the remaining ribs are the lower torso enhanced buoyancy regions.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcy et al. (US 5,823,838) in view of Khanamirian (US 6,235,661). Darcy does not disclose a fabric sheet of the pocket being laminated to the flotation element. Khanamirian discloses in figures 2 the practice of laminating pocket fabric to the enclosed flotation element. Khanamirian teaches that the lamination produces an ergonomically contoured design which provides the wearer superior fit, form, function, protection, and is aesthetically pleasing. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Darcy by using the lamination taught by Khanamirian. The motivation would be to provides the wearer superior fit, form, function, protection.

21. Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcy et al. (US 5,823,838) in view of Kroll (US 6,007,395). Darcy discloses the elements of claim 19. Darcy does not disclose the material of the vest, and therefore, does not disclose if it protects the wearer from solar radiation. It is well known and common to manufacture elasticized life-vest garments, such as that of Darcy, from materials such as nylon or neoprene which provide at least some degree of protection

form solar radiation. Kroll teaches that when someone wears a traditional lifejacket, the area under the life jacket receives no tan. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the Darcy garment from a traditional material, such as nylon or neoprene. The motivation would be to manufacture the life vest garment using known materials.

22. Claims 19, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darcy et al. (US 5,823,838). Darcy discloses the elements of claims 19 and 28. Darcy does not disclose that the unitary flotation element comprises at least fifty percent of the total buoyant force provided by the unitary flotation element and the pair of rear flotation elements. Darcy shows that smaller pockets can be combined into a single larger pocket (31). Therefore, it is within the range of knowledge of the skilled artisan to size and shape the pockets however he sees fit. Using Darcy as a starting point, it would be within the range of routine experimentation to make a single pocket that is at least the same size as two pockets on the rear of the jacket. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to make a single pocket that is at least as big as a combined pair of rear pockets. The motivation for such experimentation would be to optimize the parameters of buoyancy and articulation. A single pocket that is the same size or larger than the combined size of a pair of pocket will have at least approximately the same amount of buoyant material as the pair of pockets, and therefore, will provide at least approximately fifty percent of the total buoyant force.

23. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frieder et al. (US 2,629,118). Frieder shows a flotation swimsuit comprising a form fitting torso covering (10). Outer fabric (86) is sewn to the inner lining (10) and creates a pocket in which a flotation element is disposed. The flotation element comprises a backsheet (12) and enhanced buoyancy regions (13). Frieder does not expressly disclose the recited method steps. The steps, however, are inherent in the making and use of the Frieder apparatus. The skilled artisan, in making the Frieder apparatus must necessarily provide the form fitting covering, must necessarily provide the flotation element, must necessarily position the flotation element at the desired location on the torso covering, and must necessarily secure the flotation element within the pocket. Since the recited method steps are inherent in the making and use of the Frieder apparatus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the recited method steps. The motivation would be to make the Frieder apparatus.

Allowable Subject Matter

24. Claim 15 is allowed.

Response to Arguments

25. Applicant's arguments with respect to claims 19-21 and 23-36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McMahon ('892) shows a flotation swimsuit with a garment with pockets, flotation elements in the pockets, and a zipper. Shaffer ('327) shows a flotation swimsuit with a garment with a pocket and a flotation element disposed within the pocket.

27. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright
Patent Examiner
Art Unit 3617

ANDREW D. WRIGHT
PRIMARY EXAMINER
Ar 12/21/04